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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,010	07/20/2004	Katsuhiko Oomori	1297.43994x00	8967

20457 7590 06/12/2006

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EXAMINER

CARIASO, ALAN B

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/502,010

Applicant(s)

OOMORI ET AL.

Examiner

Alan Cariaso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 11 and 12 is/are allowed.
- 6) ☒ Claim(s) 10, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20060315</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt of applicant's response filed March 15, 2006 is acknowledged. Claims 1-8 and 10-16 are pending. Claims 14-16 are newly submitted.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: a protective space surrounded by the handle grip and the body ... the light unit being disposed within the protective space.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by VAN OSENBRUGGEN (US 2002/0131267 A1).
5. VAN OSENBRUGGEN discloses a power tool (figs.3-4) comprising: a body housing (300,301) inherently housing a motor as a drive power source and having an end output unit (402); a handle grip (306) integral with the body (301); and a light unit (302) disposed to one of the handle grip (505 in fig.5) and the body (300,301, figs.3-4) and having a light-emitting element (302) for illuminating the work space worked on by spindle (402) or abrasive disk (307) at a distal end of the end tool (402 or 307 or

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paragraph 0039); wherein the light-emitting element (302) comprises a yellow LED (paragraph 0074, last few lines); whereas the field of invention includes electric drivers or drills (paragraphs 0001 & 0039) capable of driving fasteners (by the drill bit, paragraph 0102) of which the light unit is applicable to such power tools.

6. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by DAVIS (US 6,565,227 B1).

7. DAVIS discloses a power tool (fig.4) comprising: a body housing (drill 212) inherently housing a motor as a drive power source and having an end output unit (front end of drill 212 adjacently holding drill bit or end tool 216) with end tool (216) capable of driving a fastener; a handle grip integral with the body (212), the handle grip (fig.4) extending generally perpendicular to the body providing a space surrounded by the handle grip and the body; and a light unit (210) having a light-emitting element (104, fig.1) capable of illuminating a fastener located at a distal end of the end tool (216), the end tool being driven by the motor to tighten the fastener to a workpiece; a pull trigger disposed at a top part of the handle grip (fig.4), the light unit (210) being disposed within the protective space and at position below the body (212) and above the trigger (fig.4); and a transparent lens (108 or 103 in fig.1) disposed in front of the light unit (101).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over VAN OSENBRUGGEN (US 2002/0131267 A1) in view of HUANG (US 5,412,546).

10. VAN OSENBRUGGEN discloses the claimed invention including the handle grip (306) extends in a direction transverse (fig.4) to an elongated direction of the body (301) inherently housing the motor, and the end output unit (402). However, VAN OSENBRUGGEN does not disclose the end output unit extending in the elongated extension direction of the body.

11. HUANG teaches the end output unit (driving tip 105) extending in the elongated extension direction of the body (housing 101) for the purpose of providing the power tool an effective form that allows portability and driving fasteners in the direction of the body of the power tool. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the illuminated power tools of VAN OSENBRUGGEN including an electric driver (paragraphs 0001,0039,0102) having a form where the end output unit extends along the elongate extension of the tool body as taught by HUANG in order to effectively handle by hand to drive a fastener in the direction of the body of the power tool.

Allowable Subject Matter

12. Claims 1-8, 11 and 12 are allowed.

13. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: Claims 1-8, 11, 12 and 15 have allowable subject matter not suggested by the prior art of record: a lever spaced away from the handle grip with a predetermined gap therebetween, wherein the lever is pivotally movably supported a rear lower portion of the handle grip and extends frontwardly along the lower portion of the handle grip, the light emitting element being disposed at a free end portion of the lever; the switch means for switching the light-emitting element on and off, the switch means being disposed separately from the trigger for starting driving of the motor, in combination with an off circuit for automatically turning the light-emitting element off at a predetermined time after the light-emitting element turns on; the light unit being generally ring-shaped around a circumference of the hollow cylindrical part, the light unit comprising a ring shape lens having a configuration in conformity with an outer circumferential configuration of the body and the lens has an outer diameter in a radial direction of the body gradually smaller toward a front end of the body; the light unit is disposed within the protective space at the position below the body and immediately above the trigger.

Response to Arguments

15. Directed to the rejection of claim 10 as being anticipated by Van Osenbruggen, applicant argues that the following particular features are not disclosed or inherent in

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Van Osenbruggen: "a body housing the motor and having an end output unit for chucking an end tool driving a fastener", as well as "a light unit disposed to one of the handle grip and the body, and having a light-emitting element for illuminating a fastener located on a distal end of the end tool, the end tool being driven by the motor to tighten the fastener to a workpiece".

16. In response, it is reviewed that Van Osenbruggen is adequate in disclosing the claimed structure and is capable in performing the recited functions. Van Osenbruggen adequately discloses a body housing (at least "angle grinder 301" of figs.3-4, paragraph 0073) having an end output unit ("spindle 402"). As for the recitation "for chucking an end tool driving a fastener" and "for illuminating a fastener located on a distal end of the end tool, the end tool being driven by the motor to tighten the fastener to a workpiece", any recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Van Osenbruggen clearly recite "electric drills, drivers, electric angle grinders" in paragraph 0001 and "electric drill ... illuminator being capable of emitting light onto one or more zones within the working area of the tool" in paragraph 0039, the end tool includes a driver or drill bit (paragraph 0102), capable of driving a fastener at its distal end. These further references to disclosed structure from particular paragraphs and statement of capability are set forth in this action, show how Van Osenbruggen meet the claimed structure and intended

use. No teaching or explicit statement is necessary from Van Osenbruggen to show intended use because Van Osenbruggen discloses the claimed structure.

17. Directed to the rejection of claim 13 as being anticipated by Davis, applicant makes reference to the specification (pages 37-39) citing "the light unit 220 is disposed immediately above the trigger 213 and has one light-emitting element 223 originated to the front of the body 210" and further directs to a citation at page 38, line 17 to page 39, line 3, thus concluding that it is apparent that a protective space is provided.

18. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the light unit 220 is disposed immediately above the trigger, ...the light unit 220 is located directly above the trigger 213) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, given the emphasis on the protective space or spaces surrounded by the handle grip and the body as stated by applicant on page 12 of the remarks, an objection to the specification is made above, as lacking support for this protective space(s). In regards to the claimed protective space or spaces surrounded by handle grip and body, it is broadly viewed as the full area formed by the full extent or respective lengths of the hand grip and body, commonly shown by both applicant's figures and Davis' figures.

19. Applicant further argues that the light unit 210 of Davis is not within the protective space formed by the combination of the handle grip and the body, noting that the light

unit 210 is not located in the vicinity of the handle grip in Fig.4 of Davis, nor is the light unit (210) positioned above the trigger of the handle grip and below the body in the proximity of the handle grip, nor above the trigger within the protective space.

20. In response, as broadly interpreted, Davis is adequate in showing that the light unit (210) is above the trigger when the power tool's handle grip is in the upright position viewing in any elevational profile, and that the light unit (210) is below the body (212) by apparently being attached at a bottom outside surface of the body (212).

21. Further directed to the rejection of claim 13 as being anticipated by Davis, applicant argues that while Davis discloses a drill with a drill bit 216, as shown in Fig.4 thereof, Davis describes the drill 216 being utilized for drilling holes and fails to disclose or teach an end output unit for chucking an end tool driving a fastener and enabling tightening of the fastener to a workpiece, in the manner recited in claim 13.

22. In response, Davis adequately discloses an end output unit (front end of drill 212 adjacently holding drill bit or end tool 216) as set forth in the rejection above. The recitation "for chucking an end tool driving a fastener and enabling tightening of the fastener to a workpiece", any recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Davis discloses the claimed structure of an end output unit (front end of drill 212 adjacently holding drill bit or end tool 216), a drill bit (216) as the end tool and light-emitting element (104, fig.1), as set forth in the rejection of claim 13 above. The rejection of

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claim 13 adequately addresses the intended use recitations by stating that the “end tool (216)” of Davis is “capable of driving a fastener” and that “light-emitting element (104, fig.1)” is “capable of illuminating a fastener located at a distal end of the end tool (216), the end tool being driven by the motor to tighten the fastener to a workpiece”. No teaching or explicit statement is necessary from Davis to show intended use because Davis discloses the claimed structure.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. GIBBLE (US 2,855,679) shows an annular or ring-shaped light source and a chuck end (11) for a drive tool at the front end of the power tool body. Previously cited is LIU (US 6,168,287) which shows in fig.2 a drive tool (130) driving a bolt or fastener (40) by the power tool device. VAN GENNEP (US 5,168,780) show a power tool that exchangeably drives a drill and screwdriver.

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

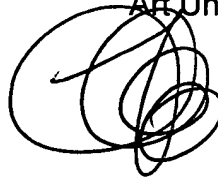
Alan Cariaso

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Primary Examiner
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June 8, 2006
AC

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